



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,202	06/28/2000	Frank J. Jakubaitis	62941.002313	7617
27682 7590 01/25/2008 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT RIVERFRONT PLAZA, EAST TOWER 951 EAST BYRD ST. RICHMOND, VA 23219-4074				
EXAMINER				
POND, ROBERT M				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
01/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7 *Ex parte* FRANK J. JAKUBAITIS

8
9 Appeal 2006-2420

10 Application 09/607,202

11 Technology Center 3600

12
13
14 Decided: January 18, 2008
15

16
17 Before ALLEN R. MacDONALD, ROBERT E. NAPPI¹, and
18 ANTON W. FETTING, *Administrative Patent Judges*.

19
20 FETTING, *Administrative Patent Judge*.

21

¹ The appeal was originally heard by Administrative Patent Judges Levy, Nappi, and Fetting. Subsequent to the decision mailed February 20, 2007, Administrative Patent Judge Levy retired. Subsequent to remand, the panel was changed to include Administrative Patent Judge MacDonald (replacing Judge Levy). *See In re Bose Corp.*, 772 F.2d 866, 869-70 (Fed. Cir. 1985).

DECISION ON REQUEST FOR REHEARING

STATEMENT OF CASE

A merits panel of the Board entered a decision on appeal on February 20, 2007. *Ex parte Jakubaitis* Appeal 2006-2420 (Bd. Pat. App. & Int. Feb. 20, 2007). An appeal from that decision was timely taken to the U.S. Court of Appeals for the Federal Circuit. In due course, the Federal Circuit entered a mandate remanding to the Board for further proceedings. *In re Jakubaitis*, No. 2007-1371 (Fed. Cir. Jul 3, 2007). A panel now proceeds to implement the Federal Circuit's mandate. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellant also filed a paper entitled RECONSIDERATION OF *EX PARTE FRANK J. JAKUBAITIS*: REASONS WHY THE BOARD'S FEBRUARY 20, 2007 DECISION IS IN ERROR on October 12, 2007. In that paper, the Appellant requested that we (1) reconsider the February 20, 2007 Decision, and (2) reverse the Examiner's rejections (Request 22).

Frank J. Jakubaitis (Appellant) seeks review under 35 U.S.C. § 134 of a final rejection of claims 1, 4 through 9, and 12 through 15 the only claims pending in the application on appeal.

The Examiner rejected claims 1, 6 through 9, and 13 through 15 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, and Freeny; claims 4 and 12 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny and Official Notice; and claim 5 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny, and White. The panel affirmed these rejections in the Decision. The Appellant seeks reconsideration of the decision to affirm these rejections.

We have considered the arguments set forth by the Appellant in the Request and reconsidered the Decision in view of the Appellant's arguments. We GRANT the REQUEST FOR REHEARING in that we VACATE the February 20, 2007 Decision and ENTER the following new Decision. The disposition of the claims is set forth in this new Decision in which we AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).

The Appellants state that they have invented a way for distributing digital works among a retail merchant at a merchant node, a remote server, and a customer at a customer node through a public communications network (Specification 2:10-13).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method for distributing digital works among a retail merchant having a merchant node, a remote server, and a customer at a customer node, each digital work having identification data associated therewith, the remote server being intermittently coupled through a communications link which includes a communications network to the customer node, the method comprising the steps of:

[1] storing the digital works and their associated identification data on a memory of the remote server;

[2] purchasing from the retail merchant a package

[2a] including a card associated with a desired one of the digital works,

[2b] wherein the card includes a card identifier,

[2b1] the card identifier being displayed on an outer surface of the card,

1 [2b2] the card identifier being a code that includes
2 the desired digital work's identification data to
3 uniquely identify the digital work and the package
4 and card being purchased,
5 [2c] the outer surface of the card or the package further
6 displaying a description of the content of the digital work
7 to be downloaded;
8 [3] sending a request from a merchant node associated with the
9 retail merchant to the remote server
10 to set a status of the desired digital work as available for
11 one-time access based on the card identifier of the card
12 associated with the digital work,
13 the remote server
14 receiving the request and
15 searching the digital works stored on the remote
16 server
17 for the desired digital work specified by the
18 card identifier in the received request from
19 the merchant node and
20 setting the status of the desired digital work as
21 available for access;
22 [4] sending a request
23 to access the desired digital work from the customer node
24 through the communications network
25 to the remote server,
26 the request specifying the desired digital work's
27 identification data included in the card identifier
28 displayed on the outer surface of the purchased
29 package;
30 [5] receiving at the remote server the request to access the
31 desired digital work;
32 [6] searching the digital works stored on the remote server for
33 the desired digital work specified by the identification data

1 associated with the card identifier displayed on the outer
2 surface of the purchased card in the received request;
3 [7] identifying the digital work based upon the received
4 identification data;
5 [8] transmitting the desired digital work from the remote server
6 through the communications network to the customer node;
7 [9] receiving at the customer node the desired digital work; and
8 [10] storing the desired digital work
9 on a memory of the customer node
10 such that the digital work is available for subsequent use
11 by the customer at the customer node after the customer
12 logs off of the remote server.
13

14 PRIOR ART

15 The Examiner relies upon the following prior art:

16 Freeny	US 4,528,643	Jul. 9, 1985
17 Reber	US 5,995,105	Nov. 30, 1999
18 Fiala	US 5,918,909	Jul. 6, 1999
19 White	US 6,169,975 B1	Jan. 2, 2001

20

21 REJECTIONS

22 Claims 1, 6 through 9, and 13 through 15 stand rejected under 35
23 U.S.C. § 103(a) as obvious over Reber, Fiala, and Freeny.

24 Claims 4 and 12 stand rejected under 35 U.S.C. § 103(a) as obvious
25 over Reber, Fiala, Freeny, and Official Notice.

26 Claim 5 stands rejected under 35 U.S.C. § 103(a) as obvious over
27 Reber, Fiala, Freeny, and White.

ISSUES

The issues pertinent to this request are whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1, 6 through 9, and 13 through 15 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, and Freeny; claims 4 and 12 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny, and Official Notice; and claim 5 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny, and White.

Appellant has presented numerous arguments in the Briefs and the Request for rehearing. These arguments present us with the central issue of whether one skilled in the art would have combined Reber's teaching of using a card as a mechanism for distributing downloads of digital works with Reber system for selling and controlling downloaded digital works and Fiala's teachings directed to an authorization process for prepaid cards. We will address the central issue first and then separately address the individual arguments presented by Appellant.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are supported by a preponderance of the evidence.

Appellant's Disclosure

01. A "digital work" is not lexicographically defined by Appellant. However, the Appellant discloses it in preferred embodiments. Each digital work is disclosed by Appellant as including a text, audio, video, or multimedia work which has been translated to or

created in a digital form and which can be recreated or accessed using suitable interpreters, such as software programs. The Appellant discloses digital work examples as a book, a periodical subscription (such as a newspaper or magazine), a song or collection of songs, a movie, a software program, or the like (Specification 4:17-22).

02. A “package” is not lexicographically defined by Appellant. However, the Appellant discloses each digital work as being presented in a package which is available for purchase at a retail merchant, such as a convenience store, a gasoline station, a supermarket, an office supply outlet, a mall kiosk, or the like (Specification 5:1-4).

03. A “customer node” is not lexicographically defined by Appellant. However, the Appellant discloses a customer node as a conventional computer equipped with memory (such as RAM, ROM, and a hard disk), at least one processor, an input device (such as a keyboard, a mouse, or other pointing device, and/or the like), and an output device (such as a display or the like). The customer node so described also includes communications equipment for connecting to the Internet, such as a modem, and connects to the Internet via a public or private connection using such equipment (Specification 5:15-21).

04. The Appellant further discloses alternative customer node embodiments as other types of systems with similar equipment and components, such as a pen-based system, a kiosk, or the like (Specification 6:14-16).

05. A “merchant node” is not lexicographically defined by Appellant. However, the Appellant discloses a merchant node as being a conventional computer equipped with memory (such as RAM, ROM, and a hard disk), at least one processor, an input device, an output device, and communications equipment for connecting to the Internet (such as a modem) (Specification 6:17-20).
06. The Appellant discloses an equivalency between the structural composition of the merchant and customer nodes by describing that the merchant node components may be identical to the components described with respect to the customer node (Specification 6:22-7:2).
07. The Appellant further describes alternative merchant node embodiments as other types of systems with similar equipment and components, such as a pen-based system, a kiosk, or the like (Specification 7:8-10).
08. An “identification data” is not lexicographically defined by Appellant. However, the Appellant discloses as embodiments: a unique 16-character alphanumeric identifier; a user name and/or password; and other forms of identifiers, such as alphabetic-only or numeric-only identifiers. The Appellant discloses such an identifier as including any number of characters (Specification 9:2-6).
09. The Appellant discloses the identifier as embodied such that the retail merchant inputs the identifier into the merchant node using a

1 standard input device, such as typing the identifier using a
2 keyboard, scanning the identifier with a bar code scanner, reading
3 the identifier from the magnetic strip using a magnetic card reader,
4 or the like (Specification 9:21-10:2).

5 10. The Appellant discloses the identifier as embodied such that the
6 customer inputs the identifier for the desired digital work using a
7 standard input device, such as typing the identifier using a
8 keyboard or reading the identifier from the magnetic strip using a
9 magnetic card reader, and then clicks the "Submit" button
10 (Specification 12:7-10).

11 11. The Appellant's original disclosure identifies that, when the
12 desired digital work is *received* at the customer node, it is stored
13 on the memory of the customer node "for subsequent access and
14 use by the customer" (Specification 12:17-19).

15 12. The modifier "subsequent" in FF 11 is, on its face by the terms
16 of that sentence within the Specification, relative to *reception* of
17 the work.

18 13. The disclosure as filed contained no written description of
19 logging off or otherwise exiting the remote server as currently
20 recited in the final phrase "such that the digital work is available
21 for subsequent use by the customer at the customer node after the
22 customer logs off of the remote server" of claim 1. This limitation
23 was added to claim 1 by amendment dated February 24, 2005.
24 The Appellant did not present any evidence as to support for this
25 amendment in the original disclosure.

Facts related to Claim Construction

14. The disclosure contains no lexicographic definition of “digital work.”

15. The ordinary and customary meaning of a “work” as a noun within the context of the claimed subject matter is something that has been produced or accomplished through the effort, activity, or agency of a person or thing.²

16. The disclosure does state that each digital work includes a text, audio, video, or multimedia work which has been translated to or created in a digital form (FF 01).

17. The disclosure provides examples of digital works as a book, a periodical subscription (such as a newspaper or magazine), a song or collection of songs, a movie, a software program, or the like (FF 01).

18. The disclosure contains no lexicographic definition of “customer node.”

19. The phrase “customer node” is, on its face, a noun, “node,” modified by a noun adjective “customer.” The phrase does not limit the relationship between the noun “node” and its noun adjective “customer.”

Reber

20. Reber is directed toward accessing digital products by automatically linking a user to a resource, itself a digital product,

1 in an electronic network using a network navigation device.

2 Reber's device includes a human-viewable image intuitively
3 associated with the resource and machine-readable data for
4 navigating to the electronic address (Reber 2:38-46).

5 21. Reber describes a usage parameter associated with the network
6 navigation device that can be monitored so that a predetermined
7 measure of use is provided. Reber describes that, by using this
8 usage parameter, embodiments of the present invention may be
9 used for prepaid use, the degree of usage limited by the usage
10 parameter. (Reber 2:50-56). Thus, at the time of usage, such an
11 embodiment would have been prepaid, i.e., would have been
12 conveyed to the user in exchange for payment prior to use. Since
13 a purchase is acquisition through the payment of money or its
14 equivalent, and such an embodiment would have been an
15 acquisition of Reber's card by the user through payment by virtue
16 of being prepaid prior to use, this embodiment would have been
17 purchased by the time it is used. Since a customer is one who
18 buys goods or services,² the computer node at which such an
19 embodiment would be used for downloading would be associated
20 with the user who purchased the device, or someone who stands in
21 that purchaser's shoes if the card was transferred, i.e., a customer.

22 22. Reber Figs. 2, 4, and 6 show exemplary cards for acquiring
23 digital works, which Reber refers to as network navigation
24 devices. The card's structure is portrayed in FIG. 1 within a block

² *American Heritage Dictionary of the English Language* (4th ed. 2000).

1 diagram as item 10. Reber's network navigation device is a
2 package including a substrate 12, a first human-viewable image 14
3 supported by the substrate 12, and machine-readable data 16
4 supported by the substrate 12. The package may also include a
5 second human-viewable image 18 supported by the substrate 12
6 (Reber 2:57-64).

7 23. Reber's first human-viewable image indicates a resource in an
8 electronic network. Reber's second human-viewable image
9 indicates a service which provides the resource to a network
10 access apparatus via the electronic network. Reber's machine-
11 readable data identifies the specific resource to the service (Reber
12 2:65-3:3).

13 24. Reber's service which provides the resource to an end user is
14 provided by a node in the electronic network. Reber's resource
15 can be locally present at the node or be at another electronic
16 address in the electronic network (Reber 3:4-10).

17 25. Reber describes the focused embodiment being on a network
18 such as the Internet, the World Wide Web, or an intranet. In this
19 case, the machine-readable data may include at least a portion of a
20 uniform resource locator (URL) or an Internet Protocol (IP)
21 address to identify the resource (Reber 3:11-21).

22 26. Reber's substrate is formed by a substantially flat piece of
23 material, which may be paper, cardboard, and plastic (Reber 3:22-
24 26).

- 1 27. Reber's substrate can be card-shaped. For example, it can have
2 the size of a business card, a credit card, an index card, a trading
3 card (e.g., a baseball card), or a playing card (e.g., from a deck of
4 playing cards). In other embodiments, Reber's substrate includes a
5 page in a book, a magazine, a newspaper, or other printed
6 publication (Reber 3:31-41).
- 7 28. Reber's human-viewable images may be printed directly onto
8 the substrate or printed onto a second substrate for affixing or
9 adhering to a surface of the substrate with an adhesive backing.
10 As another alternative, the human-viewable images can be
11 packaged within the substrate (Reber 3:52-62).
- 12 29. Reber's first human-viewable image can include textual and/or
13 graphical information which provides an intuitive and/or
14 understandable representation of the resource. Thus, the first
15 image identifies the resource to the user. The second human-
16 viewable image can similarly include textual and/or graphical
17 information which indicates to the end user which service is
18 providing the resource (Reber 3:63-4:12).
- 19 30. Reber's second human-viewable image can indicate any
20 combination of: a client routine utilized to display the resource; a
21 network provider which connects the network access apparatus to
22 the electronic network; and a service which provides a link to the
23 resource (Reber 4:18-24).
- 24 31. Reber's machine-readable data 16 can be supported by the
25 substrate in a variety of ways. In particular, Reber describes

embodiments where the machine-readable data includes printed data, in which case the machine-readable data can be printed directly onto the substrate, printed onto a second substrate for affixing or adhering to a surface of the substrate, or can be contained within the substrate. In these embodiments, the printed data can include a bar code (Reber 4:25-34).

32. Reber's network access apparatus can have a variety of forms, including but not limited to, a general purpose computer, a network computer, a network television, an internet television, and a portable wireless device (Reber 5:14-17).

33. In one Reber application, the human-viewable printed image can include a figure in a book or the like. Here, the printed data may direct a user to a resource having information associated with the figure, with the printed data that identifies that particular resource (i.e., uniquely identifies the resource) included in a caption for the figure (Reber 7:32-38).

34. Reber's machine-readable data provides navigation instructions that tell the network access apparatus how to link to, i.e., to uniquely identify and find, the resource. As described earlier, the navigation instructions can include at least a portion of a URL or at least a portion of an IP address for the resource (Reber 10:1-7).

35. Because a URL can includes a protocol, which include: "file:" for accessing a file stored on a local storage medium; "ftp:" for accessing a file from an FTP (file transfer protocol) server; "http:" for accessing an HTML (hypertext marking language) document;

"gopher:" for accessing a Gopher server; "mailto:" for sending an e-mail message; "news:" for linking to a Usenet newsgroup; "telnet": for opening a telnet session; and "wais:" for accessing a WAIS server, Reber describes that its network navigation device embodiments include those for automatically initiating a task using any of these enumerated protocols (Reber 10:11-22). In particular, the ftp protocol uniquely identifies and accesses a specific file from an FTP server. Thus, one of Reber's embodiments uses the printed identifier to uniquely identify and access a specific digital file, that is requested by the signal sent to the FTP server from reading the printed identifier on Reber's device, that is located on an FTP server.

36. Reber describes the content from Reber's resource as including audible information and/or visual information, such as graphical information and/or textual information. Reber describes examples of the content as any combination of a file from a local hard drive, a file from an FTP server, an HTML document, content from a Gopher server, a message from a newsgroup, a transmission from a Telnet session, a transmission from a WAIS server, an animation file, a movie file, and an audio file (Reber 11:30-38).

37. Reber describes an optional step of monitoring a usage parameter associated with the network navigation device. Reber's usage parameter can measure the usage in terms of: (i) units of time (e.g., minutes or hours); (ii) monetary units (e.g., dollars); or (iii) a number of uses (Reber 12:40-44).

38. Reber optionally limits subsequent usage with the network navigation device once the usage parameter attains a predetermined threshold. Reber describes as examples subsequent usage limited if usage reaches: (i) a predetermined time limit; (ii) a predetermined monetary limit; or (iii) a predetermined number of uses limit. Reber describes mechanisms for limiting subsequent usage by either: (i) inhibiting or prohibiting all subsequent usage associated with the network navigation device; or (ii) allowing limited subsequent usage (Reber 12:45-55).
39. Reber describes a server to authenticate the network navigation device using a database when the user uses the device to request the resource described on Reber's card. The database includes records corresponding to network navigation devices. Each record includes a code which identifies a respective one of the network navigation devices. Reber's server authenticates a network navigation device based upon a code encoded in the received signal, such as by checking if the code in the signal matches a code in the database 152 (Reber 12:66-13:8).
40. Each record in Reber's database can additionally include a resource location, a usage limit, and a usage parameter. The resource location identifies a location of the resource associated with the network navigation device. The resource location can be a full address, a partial address, or even as minimal as a name of a resource on the server (Reber 13:9-17).
41. Reber shows an example of a resource limited to single use (Reber, Fig. 11:Code 1, see also Reber 14:57-59).

42. Reber's usage limit specifies a threshold of usage at which subsequent usage is limited. Reber's usage limit can limit a number of uses, a time duration of usage, or a monetary measure of usage. Alternatively, the usage limit can indicate that an unlimited use of the network navigation device is permitted (Reber 13:18-23).
43. Reber's usage parameter indicates an amount of usage associated with the network navigation device. (Reber 13:24-25).
44. After authenticating the network navigation device, Reber's server identifies the resource to be provided to the end user using the contents of a resource location field in the database. The server retrieves the resource, which may be available only on Reber's server (Reber 13:28-38).
45. Reber's server can modify the content of the resource to include a logo or the like to identify a service provided (Reber 13:55-59).

Freeny

46. Freeny is directed toward reproducing or manufacturing material objects for purchase at point of sale locations only with the permission of the owner of the information, thereby assuring that the owner of the information will be compensated in connection with such reproduction (Freeny 4:8-13).
47. Freeny permits the sale of material objects embodying information (Freeny 4:13-18).
48. The term "material object" as used by Freeny means a medium or device in which information can be embodied or fixed and from

1 which the information embodied therein can be perceived,
2 reproduced, used or otherwise communicated, either directly or
3 with the aid of another machine or device. Freeny provides as
4 examples, a cassette tape, a floppy disk, a phonograph records, an
5 8-track tape, a reel-to-reel tape, a video disc, a handheld calculator
6 or electronic game, a greeting card, a map, and sheet music
7 (Freeny 4:36-59).

8 49. Freeny's system makes use of an information control machine
9 that acts as a server for downloading predetermined or preselected
10 information and an information manufacturing machine that acts
11 as a node to receive downloads (Freeny 5:1-31).

12 a. Freeny's information control machine is constructed to
13 perform functions such as: receiving, encoding and storing
14 received information; receiving request reproduction codes
15 requesting to reproduce certain preselected information at a
16 particular information manufacturing machine; providing
17 authorization codes authorizing the reproduction of certain
18 preselected information at a particular information
19 manufacturing machine; receiving file reproduce codes via
20 an input line requesting the reproduction of the information
21 stored in the information control machine; providing the
22 information so stored to particular information
23 manufacturing machines; receiving file transmit codes
24 requesting the reproduction of the information stored in the
25 information control machine; and providing the information

1 stored therein to particular information manufacturing
2 machines.

3 b. Freeny's information manufacturing machine is constructed
4 to: receive and store encoded information; receive and
5 provide request reproduction codes; decode preselected
6 information in response to receiving an authorization code;
7 and provide certain preselected decoded information to a
8 reproduction unit adapted to reproduce received information
9 in a material object.

10 50. Each of Freeny's information manufacturing machines is
11 located at a point of sale location and each point of sale location is
12 located remotely with respect to the other point of sale locations.
13 Freeny's information control machine is located at a location
14 remote from each of the point of sale locations and the
15 information manufacturing machines. The point of sale location is
16 a location where a consumer goes to purchase material objects
17 embodying predetermined or preselected information (Freeny
18 5:32-50).

19 51. When a request is made at one of Freeny's point of sale
20 locations for a material object embodying certain selected
21 information, the request is entered into the information
22 manufacturing machine in the form of a request reproduction code
23 and, in response to such a request, the information manufacturing
24 machine provides a request reproduction code requesting to
25 reproduce the certain selected information in a material object.
26 The request reproduction code is received by the information

1 control machine, and, in response to receiving the request code,
2 the information control machine, if approved, provides an
3 authorization code which is received by the information
4 manufacturing machine. In response to receiving the
5 authorization code, the information manufacturing machine
6 decodes the preselected information stored in the information
7 manufacturing machine and provides the decoded information.
8 The reproduction unit is constructed and adapted to receive the
9 decoded information and to reproduce the preselected information
10 in a material object. Thus, the information manufacturing units
11 are constructed to reproduce preselected information in material
12 objects only in response to receiving an authorization code and,
13 thus, preselected information is embodied or reproduced in a
14 material object at a point of sale location only with the permission
15 of the owner of the information, such permission being indicated
16 by the authorization code provided by information control
17 machine (Freeny 5:60 – 6:23).

18 52. Freeny describes the obligations of the owner of recordings as
19 usually to pay recording artists and songwriters in connection with
20 the sale of recordings embodying the performances of such
21 recording artists or using musical compositions composed by such
22 songwriters. Freeny describes programming its information
23 access unit to credit the account of the appropriate recording artist
24 and the appropriate songwriter or publisher each time a particular
25 recording is authorized to be reproduced, which Freeny states

should reduce the accounting problems traditionally encountered in this area (Freeny 15:12-23).

Fiala

53. Fiala is directed to packaging for well-known prepaid debit cards. Such debit cards are associated with a prepaid metered account, and the account is debited as purchases are made by a consumer (Fiala 1:26-29).

54. Fiala describes prior art prepaid metered accounts associated with debit cards as being well-known for providing access to goods and services, e.g., telephone services. Fiala describes the use of such cards as typically having a personal identification number ("PIN") and being sold at a retail outlet for a certain price. This PIN number is associated with an already-activated metered account that is pre-credited with a certain predetermined value representing the value of services, e.g., telephone services, being purchased. Then, as the cardholder uses the telephone services, the cardholder provides the PIN number and the account is successively debited for the services provided until the value of the card is exhausted (Fiala 1:37-42).

55. Fiala describes a problem with theft of cards if a person obtains knowledge of the PIN of a pre-activated card. Fiala describes a solution to this problem, by providing a PIN and activating the card at the time of sale (Fiala 1:52-60, 2:47-53).

56. The activation of Fiala's card is performed after it is paid for. A control number is read from the card and transmitted to a

1 computer to identify the associated metered account in a manner
2 understood by those skilled in the art, and the computer then
3 activates that particular associated metered account. The metered
4 account may have been credited with a certain predetermined
5 balance when the metered account was entered into the digital
6 computer, but, if not, the digital computer will now credit the
7 metered account with a certain predetermined balance (Fiala
8 19:57-20:5).

9 *Knowledge of One of Ordinary Skill*

10 57. File transfer protocol (ftp) as referred to by Reber (see fact 35)
11 is essentially a file transfer (upload or download) mechanism. As
12 such, after an ftp session is initiated (by logging on), and in
13 response to an ftp download command, the ftp server copies a file
14 from a remote location to the local computer, where the copy that
15 has been downloaded will continue to reside after the ftp operation
16 is completed and the user terminates (logs off) the ftp session.³

17 58. To look up an entry in a database is referred to by those of
18 ordinary skill as to search the database.

19 59. A file system is known to those of ordinary skill to be a
20 database whose directories and files are searched in the
21 performance of file operations.

22 60. The arts pertinent to the claimed subject matter include internet
23 communications and communication protocols, sales systems in

³ See, for example, the ftp specification at <http://www.ietf.org/rfc/rfc0959.txt>.

general and those for analog and digital signal products, and prepaid debit cards in particular, and network security and authorization systems.

61. The level of ordinary skill would be that of design, specification, programming and correcting of systems in these arts.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with

reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

Obviousness

A claimed invention is unpatentable if the differences between it and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is bottomed on several basic factual inquiries: “[(1)] the scope and content of the prior art are to be determined; [(2)] differences between the prior art and the claims at issue are to be ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739.

“When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or [in] a different one. If a person of ordinary skill [in the art] can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 1740.

“For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would

1 improve similar devices in the same way, using the technique is obvious
2 unless its actual application is beyond his or her skill.” *Id.*

3 “Under the correct analysis, any need or problem known in the field
4 of endeavor at the time of invention and addressed by the patent can provide
5 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

6 *Automation of a Known Process*

7 It is generally obvious to automate a known manual procedure or
8 mechanical device. Our reviewing court stated in *Leapfrog Enterprises Inc.*
9 *v. Fisher-Price Inc.*, 485 F.3d 1157 (Fed. Cir. 2007) that one of ordinary
10 skill in the art would have found it obvious to combine an old
11 electromechanical device with electronic circuitry

12 to update it using modern electronic components in order to gain the
13 commonly understood benefits of such adaptation, such as decreased
14 size, increased reliability, simplified operation, and reduced cost. . . .
15 The combination is thus the adaptation of an old idea or invention . . .
16 using newer technology that is commonly available and understood in
17 the art.

18 *Id.* at 1163.

19 ANALYSIS

20 *Claims 1, 6 through 9, 13, 14, and 15 rejected under 35 U.S.C. § 103(a) as*
21 *obvious over Reber, Fiala, and Freeny.*

22 The Appellants argue these claims as a group.

23 Accordingly, we select claim 1 as representative of the group.
24 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Board of Patent Appeals and Interferences Findings and Holdings

Before we analyze the references and the Examiner's findings, we will address claim construction. The disclosure provides no lexicographic definition of the phrases "digital work" or "customer node" (FF 14 and 18). The ordinary and customary meaning of a "work" as a noun within the context of the claimed subject matter is something that has been produced or accomplished through the effort, activity, or agency of a person or thing. The Specification indicates that each digital work includes a text, audio, video, or multimedia work which has been translated to or created in a digital form and which can be recreated or accessed using suitable interpreters, such as software programs, and the work may be a book, a periodical subscription (such as a newspaper or magazine), a song or collection of songs, a movie, a software program, or the like (FF 01). Thus, a digital work is construed as a text, audio, video, or multimedia work that has been produced or accomplished through the effort, activity, or agency of a person or thing, and which has been translated to or created in a digital form and which can be recreated or accessed using suitable interpreters, such as software programs.

The phrase "customer node" is, on its face, a noun, "node," modified by a noun adjective "customer." The phrase does not limit the relationship between the noun "node" and its noun adjective "customer" (FF 19). The Specification indicates that in preferred embodiments, the customer node is a conventional computer equipped with memory (such as RAM, ROM, and a hard disk), at least one processor, an input device (such as a keyboard, a mouse or other pointing device, and/or the like), and an output device (such as a display or the like) (FF 03). The Specification further states that in

1 alternative embodiments, the customer node may be other types of systems
2 with similar equipment and components, such as a pen-based system, a
3 kiosk, or the like (FF 04). The merchant node components may be identical
4 to the components described with respect to the customer node (FF 06). By
5 the commutative property of identity, a customer node may therefore be
6 identical to a merchant node. A merchant node may have a bar code scanner
7 and a magnetic card reader (FF 09), and accordingly so may the customer
8 node. Thus we construe the customer node to be a computer node on a
9 network that relates in some unspecified manner to a customer, which may
10 be a kiosk, and which may have a bar code scanner and magnetic card
11 reader. Any computer acting as a node upon which a file would be
12 downloaded as part of a service to or for a customer would be within the
13 scope of a customer node.

14 Having construed the pertinent terms for the limitations that are under
15 contention, we turn to the rejection under obviousness. The Supreme Court
16 has provided guidance for determining obviousness based on the *Graham*
17 factors. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). As with
18 *Graham*, we first determine the scope and content of the prior art, which we
19 set forth, *supra*, in the Findings of Fact. Next the differences between the
20 prior art and the claim are ascertained.

21 We find that Reber describes a card in a package (FF 22) that
22 pictorially describes a digital product or service along with a code that
23 uniquely identifies the product (FF 23) in bar code format (FF 31). Reber
24 describes this as being downloaded via e.g., ftp, (FF 35) which would cause
25 a request to be sent to the ftp server, the product located, and sent back to the
26 user. The product (or content) sent back to the user may be a movie or audio

file (FF 36). Thus, Reber's product is a "digital work" within the meaning of the term as used in claim 1. Following an ftp transfer described by Reber (FF 35), the download would remain even after logging off the ftp session (FF 57). Reber's embodiment that is described in detail does not explicitly describe the card being purchased, as opposed to free distribution, but in Reber's embodiment of a prepaid card, the user would be a customer at the time of use, having prepaid for the card that was purchased at the time of prepayment by the user (FF 21). Reber explicitly and repeatedly describes metering the number of uses for the card (FF 21, 37, 38, 40, 42, and 43) and shows an embodiment in which the metering is for a single use (FF 41).

Freeny describes selling a downloaded digital product to a customer (FF 49 and 51). Freeny's information control machine corresponds to the claimed remote server; Freeny's information manufacturing machine corresponds to the claimed customer node, and Freeny's point of sale location corresponds to the claimed merchant node (FF 50). Freeny's manufacturing machine is a node on Freeny's network and is used to download a file for a customer and therefore falls within the scope of the phrase "customer node." The product is downloaded after an authorization sequence (FF 49 and 51) and the number of downloads is controlled (51 and 52). Fiala is a cumulative reference that provides evidence of the notoriety of debit cards and the authorization process they entail (FF 53-56).

Thus, the limitations of claim 1 are found in Reber, Fiala and Freeny as follows

A method for distributing digital works
among a retail merchant having a merchant node, a remote
server, and a customer at a customer node, (FF 50)

each digital work having identification data associated therewith, (FF 23, and 31).

the remote server being intermittently coupled through a communications link which includes a communications network to the customer node, (FF 35, 49, and 51)

the method comprising the steps of:

[1] storing the digital works and their associated identification data on a memory of the remote server; (FF 35, 36, 39, 49)

[2] purchasing from the retail merchant a package (FF 46, 47, and 54)

[2a] including a card associated with a desired one of the digital works, (FF 22, 26-28)

[2b] wherein the card includes a card identifier, (FF 23)

[2b1] the card identifier being displayed on an outer surface of the card, (FF 20 and 23)

[2b2] the card identifier being a code that includes the desired digital work's identification data to uniquely identify the digital work and the package and card being purchased, (FF 23, 33, and 35)

[2c] the outer surface of the card or the package further displaying a description of the content of the digital work to be downloaded; (FF 20, 22, 23, and 29)

[3] sending a request from a merchant node associated with the retail merchant to the remote server (Freeny discloses sending a request as the mechanism for authorizing download - FF 49 and 51)

to set a status of the desired digital work (Reber discloses the use of a usage parameter that has been set before distribution of a card - FF 37, 38, 40, 42, 43; Freeny discloses sending a request that alters the status of a product at the time of purchase to enable for download - 49 and 51) as available for one-time access (FF 41, 51, and 52) based on the card identifier of the card associated with the digital work, (FF 39 and 40)

the remote server (FF 49 and 51)

1 receiving the request and (FF 49 and 51)
2 searching the digital works stored on the remote
3 server (FF 49 and 51)
4 for the desired digital work specified by the
5 card identifier (FF 23) in the received
6 request from the merchant node (FF 49 and
7 51) and
8 setting the status of the desired digital work as
9 available for access; (FF 37, 38, 40, 42, 43, 49, and
10 51)
11 [4] sending a request (FF 39, 49, and 51)
12 to access the desired digital work (FF 39, 49, and 51)
13 from the customer node (FF 49 and 51) through the
14 communications network (FF 39, 49, and 51)
15 to the remote server, (FF 39, 49, and 51)
16 the request specifying the desired digital work's
17 identification data (FF 39, 40, 49, and 51) included
18 in the card identifier displayed on the outer surface
19 of the purchased package; (FF 23, 39, and 40)
20 [5] receiving at the remote server the request to access the
21 desired digital work; (FF 39, 40, 49, and 51)
22 [6] searching the digital works stored on the remote server for
23 the desired digital work specified by the identification data
24 associated with the card identifier displayed on the outer
25 surface of the purchased card in the received request; (FF 39,
26 40, 49, 51, 58, and 59)
27 [7] identifying the digital work based upon the received
28 identification data; (FF 39, 40, 49, and 51)
29 [8] transmitting the desired digital work from the remote server
30 through the communications network (FF 44, 49, and 51) to the
31 customer node; (FF 49 and 51)
32 [9] receiving at the customer node (FF 49 and 51) the desired
33 digital work (FF 35, 44, 49, and 51); and
34 [10] storing the desired digital work (same as in step [9])

on a memory of the customer node (same as in step [9])
such that the digital work is available for subsequent use
(FF 35, 49, 51, and 57) by the customer at the customer
node after the customer logs off of the remote server. (FF
49, 51, and 57)

Next the level of ordinary skill in the pertinent art is resolved. We
find that the pertinent arts include internet communications and
communication protocols, file systems and file transfer systems and
protocols, sales systems in general and those for analog and digital signal
products in particular, and network security and authorization systems (FF
60). The level of ordinary skill would be that of one in designing,
specifying, programming, and modifying systems in these arts (FF 61).

Against this background, we further find that one of ordinary skill
would have combined Reber and Freeny based on their teachings and the
knowledge of such a one of ordinary skill. Reber describes controlling the
usage of the card (FF 21, 37, 38, 40, 42, and 43). However, Reber does not
describe the implementation of the status setting process within controlling
its usage. Thus, one of ordinary skill would have looked to an
implementation mechanism. Freeny describes such an implementation
mechanism for downloading digital data. Thus, one of ordinary skill would
have consulted Freeny as an example of an implementation mechanism for
Reber's setting of status. We conclude that it would have been obvious to a
person of ordinary skill in the art to have applied Freeny's teachings of
selling digital downloads and its mechanism for setting the status for
controlling downloads to Reber.

Similarly, Freeny describes the sale of downloaded digital information
and describes the implementation of both an inquiry of the status of the

1 information and the download of the information. However, Freeny does
2 not describe the implementation of entering the codes to access the
3 information into the system. Thus one of ordinary skill would have
4 consulted Reber as an example of an implementation mechanism for
5 Freeny's entry of codes.

6 We conclude that it would have been obvious to a person of ordinary
7 skill in the art to have applied Reber's teachings of using a card with
8 identifying data as a mechanism for entering codes to Freeny.

9 *Appellant's Arguments*

10 The Appellant set forth his contentions in Appeal Br. 5-14, Reply Br.
11 2-15, and Request for Rehearing 3-21. We take up each of these arguments
12 here.

13 *Appeal Brief Arguments*

14 Appeal Br. 5-6 introduces the arguments that are subsequently
15 presented. Appeal Br. 6:Bottom ¶ - 7:Top ¶ recites portions of claim 1. The
16 first argument is made in Appeal Br. 7:First full ¶, which contends that
17 Reber "relates to a very different invention." The Appellant contends that
18 Reber relates to a network navigation device that includes a human viewable
19 image intuitively associated with a resource and machine-readable data for
20 navigating to an electronic address.

21 The Appellant selectively discusses Reber's contents without
22 explaining where the argued differences occur. Reber describes a card that
23 displays an identifier which may be entered into a terminal to cause a file to
24 be downloaded. When so described, the apparent difference suggested by
25 the Appellant vanishes. We find no difference from the claim 1 requirement

1 that a card identifier is displayed on an outer surface of the card, the card
2 identifier being a code that includes the desired digital work's identification
3 data to uniquely identify the digital work and the package and card being
4 purchased (claim 1, elements 2b1 and 2b2). The card identifier is disclosed
5 as having a bar code embodiment (FF 09). Reber describes such a bar code
6 identifier (FF 31).

7 The Appellant contends that there is no teaching or suggestion in
8 Reber of digital works and/or packages or cards displaying a description of
9 the content of a digital work to be downloaded. The Appellant refers to the
10 Specification reciting examples of digital works that are given. Specification
11 4 states: "The digital work may be a book, a periodical subscription (such as
12 a newspaper or magazine), a song or collection of songs, a movie, a software
13 program, or the like." (Appeal Br. 7:Bottom two full ¶'s; See also FF 01).

14 We take these arguments to mean that the Appellant is calling for
15 evidence that the art describes the "card identifier being displayed" and
16 "uniquely identify the digital work" claim limitations. These arguments
17 have not persuaded us of error in the Examiner's rejection as we find that the
18 evidence of record teaches these limitations. As discussed *supra*, we find
19 that Reber describes cards (FF 27) which provide human viewable data (FF
20 28, 29, and 33) and machine readable data that are used to navigate (FF 34)
21 to digital works such as audible and/or visual information (i.e., an animation
22 file, a movie file, and an audio file) (FF 36); cards (FF 27); card packages
23 (FF 28).

24 The Appellant next refers to the Final Office Action finding that
25 Reber does not teach or suggest purchasing from a retail merchant a package
26 including a card associated with a desired digital work, sending a request

1 from a merchant node associated with the retail merchant to a remote server
2 to set a status of a desired digital work available for one-time access and
3 wherein a desired digital work is received at the customer node and stored
4 on a memory of the customer node such that the digital work is available for
5 subsequent use by the customer at the customer node after the customer logs
6 off of the remote server (Appeal Br. 7:Bottom ¶ - 8).

7 We are not persuaded of error in the Examiner's rejection by this
8 argument. An obviousness finding does not require an explicit teaching or
9 suggestion, *see KSR, id.* at 1740-41. Also, "[h]elpful insights ... need not
10 become rigid and mandatory formulas; and when it is so applied, the
11 [teaching-suggestion-motivation] test is incompatible with ... precedents."
12 *id.* 127 S.Ct. at 1741. Substantively, the Appellant is arguing that Reber
13 does not show the subject matter for which Freeny is applied and is
14 overlooking the portions of Reber that describe claimed subject matter.

15 We first consider what Reber does describe. We find that Reber
16 describes prepaid cards, which are necessarily purchased, by virtue of being
17 prepaid and conveyed, prior to use (FF 21); a package (FF 28) including a
18 card (FF 27) associated with a desired digital work (FF 34 and 35); sending
19 a request from a node associated with a remote server to set a status of a
20 desired digital work (FF 40) available for one-time access (FF 41); and
21 wherein a desired digital work is received at a node and stored on a memory
22 (FF 36 – ftp file transfer), the node at which the digital work is received
23 being a customer node in Reber's prepaid card embodiment, because the
24 card was purchased and the user is therefore a customer (FF 21), such that
25 the digital work is available for subsequent use by the customer at the
26 customer node after the customer logs off of the remote server (FF 57).

1 “Under the correct analysis, any need or problem known in the field
2 of endeavor at the time of invention and addressed by the patent can provide
3 a reason for combining the elements in the manner claimed.” *KSR*, *id.* at
4 1742. Reber describes card embodiments as having been prepaid and thus
5 implicitly having been purchased prior to use (FF 21), but Reber does not
6 describe such a purchase occurring at a retail merchant *per se*. Freeny
7 describes a retail merchant (FF 46). Clearly, Reber presents a problem of
8 selecting a sales channel that Freeny answers. Further, one cannot show
9 nonobviousness by attacking references individually where the rejections are
10 based on combinations of references. *In re Keller*, 642 F.2d 413, 426
11 (CCPA 1981).

12 The Appellant next argues that, in contrast to the invention set forth in
13 Appellant's independent claims, Reber relates to a navigation device having
14 human-viewable images associated with a resource (e.g., a web-page) and
15 machine-readable data for automatically navigating to that electronic address
16 (e.g., of the web-page) when it is read by a data device such that a user does
17 not have to type in an electronic address or other information. The
18 Appellant contends that this is very different than Appellant's claimed
19 invention as set forth in independent claims 1 and 9 in which a user may
20 send a request to access a desired digital work from a customer node through
21 a communications network to a remote server, in which the request specifies
22 the desired digital work's identification data included in the card identifier
23 displayed on the outer surface of the purchased package. In some
24 embodiments, the Appellant argues that the claimed invention typically
25 requires that the user type in identification data after previously manually
26 logging onto a website (Appeal Br. 8).

1 We take this argument as implying that Reber is non-analogous art,
2 but do not find it to be persuasive of error in the Examiner's rejection. We
3 disagree with Appellant's characterization of Reber. Appellant's arguments
4 overlook those portions of Reber that describe the claimed subject matter.
5 We find that Reber describes a user sending an ftp request to access a
6 desired digital work from a node through a communications network to a
7 remote server (FF 35 and 36) and the request specifying the desired digital
8 work's identification data included in the card identifier displayed on the
9 outer surface of the purchased package (FF 23 and 34). When the user uses
10 a prepaid card to do so, the user is a customer by virtue of having purchased
11 the prepaid card, and the node is then a customer node (FF 21).

12 Further the argument, that the claim requires typing identification
13 data, is not persuasive as it is not commensurate with the scope of the claim.
14 Claim 1 includes no recitation of typing data. Rather, claim 1 requires that
15 the information be sent (see copy of claim 1 reproduced *supra*, limitations 3
16 and 4), and is silent as to how the information that is sent is entered.

17 The Appellant next argues that Reber does not teach or suggest
18 purchasing from a retail merchant a package including a card associated with
19 the desired digital work in which the card includes a card identifier being
20 displayed on the outer surface of the card that includes a code having the
21 desired digital work's identification data to uniquely identify a digital work
22 and the package and card being purchased. The Appellant further argues
23 that Reber does not teach or suggest an outer surface of a card or package
24 further displaying a description of content of a digital work to be
25 downloaded. The Appellant further contends that Reber does not teach or
26 suggest the purchasing of digital works, via a card, or sending a request to

access the desired digital work from a customer node or storing the desired digital work on a memory of the customer node such that the digital work is available for subsequent use by the customer at the customer node after the customer logs off the remote server. The Appellant contends this is because Reber does not relate to the purchase, authorization for purchase, and transmission of digital works to customers at their customer node. The Appellant argues that Reber is related to a totally different invention for enabling access to a resource web page by utilizing a data reader to automatically link a user to a web-site (Appeal Br. 9:First through fourth ¶'s).

The Appellant's arguments assert a lack of a teaching or suggestion, but the Appellant overlooks many of the teachings and suggestions that Reber does provide. The Appellant has taken the entire teaching of Reber as to the creation of a, potentially prepaid, card that contains a visual identifier of a digital work for download as claimed, and condensed it down to arguing Reber produces a give-away, arguing that lack of payment negates the presence of a merchant, customer and purchase and thus arguing the inapplicability of Reber.

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR, id.* at 1740. Certainly providing for free, an item of value, which was formerly purchased, alone, is a market force within the scope of what the

Supreme Court was articulating in *KSR*. Thus mere free distribution by Reber cannot negate the applicability of Freeny's authorization method descriptions (FF 49 and 51) as a mechanism for Reber's usage control, or of Freeny's description of using a merchant's point of sale location for the channel to distribute cards such as Reber's, particularly Reber's prepaid cards (FF 21).

As to the teachings Reber provides, we find that Reber describes distributing a package including a card associated with the desired digital work in which the card includes a card identifier being displayed on the outer surface of the card that includes a code having the desired digital work's identification data to uniquely identify a digital work and the package and card being purchased (FF 21-24). Reber describes the cards as having value, being prepaid, and thus having been purchased by the time of use (FF 21), but not purchasing them at a retail merchant *per se*. Freeny describes a purchase at a retail merchant (FF 46).

We find that Reber describes the purchasing of digital works, via a card (FF 21), sending an ftp request to access the desired digital work from a node (FF 35 and 36) and storing the desired digital work on a memory of the requesting node such that the digital work is available for subsequent use by the user at the requesting node after the user logs off the remote server ftp session (FF 35 and 36). We further find that enabling access to a resource web page by utilizing a bar code data reader to automatically link a user to a web-site that is searched for a resource is within the scope of the claims, since the Specification discloses a bar code as an embodiment of an identifier (FF 09) and linking in Reber includes a database search for the resource (FF 39 and 58).

1 The Appellant next contends that Reber does not teach or suggest a
2 method for distributing digital works among a retail merchant having a
3 merchant node, a remote server, and a customer on a customer node (Appeal
4 Br. 9:Fifth and Sixth ¶'s).

5 Similar to the arguments discussed above, Appellant is arguing that
6 Reber lacks what Freeny is applied for, and overlooks the teachings of Reber
7 that do describe the contended limitations. We find that Reber describes a
8 method for distributing digital works among a remote server and user on a
9 node via ftp (FF 35 and 36), the node is used by a user who is a customer in
10 Reber's prepaid card embodiment by the time of use, having purchased the
11 prepaid card by that time (FF 21) and Freeny describes a method for
12 distributing digital works among a retail merchant having a merchant node, a
13 remote server, and a manufacturing node that is analogous to Reber's user
14 on a user node (FF 50). "Common sense teaches ... that familiar items may
15 have obvious uses beyond their primary purposes, and in many cases a
16 person of ordinary skill will be able to fit the teachings of multiple patents
17 together like pieces of a puzzle." *KSR, id.* at 1742. Thus, Appellant's
18 arguments in the fifth and sixth paragraph of the Appeal Brief have not
19 convinced us of error in the Examiner's rejection.

20 The Appellant next contends there can be no motivation to combine
21 Reber and Fiala, because Reber teaches away from purchasing. The
22 Appellant argues that Reber is directed to providing easy access to a web-
23 site resource, not purchasing a card at a retailer and authorizing access to a
24 digital work for the purchaser of the card. The Appellant argues that Reber
25 directly teaches away from purchasing a card because the navigation devices
26 of Reber are meant to be distributed freely to potential customer through

1 inserts in magazines, books, newspapers, through the mail, distributed freely
2 as business cards, etc. They are not to be purchased in a retail store with
3 retailer activation (Appeal Br. 9:Last ¶-11:Third ¶).

4 As discussed above we are not persuaded by Appellant's arguments
5 directed to Reber's embodiments of free cards. As discussed above, these
6 arguments overlook Reber's prepaid card embodiment. Appellant has not
7 persuaded us that the distinction between free distribution and revenue based
8 distribution can support patentability. As *KSR, id.* at 1740 stated, market
9 forces can create obvious variations. There is little difference between paid
10 and free distribution other than market forces. This is supported by the
11 references in Reber to alternatively limiting the use of the card to a prepaid
12 dollar balance (FF 37, 38, and 42). Thus Reber does not teach away from
13 prepaid cards as used in Fiala.

14 The Appellant further contends that, even if Reber was properly
15 combinable with Fiala, this combination would still not teach the Appellant's
16 claim limitations, and that Fiala likewise teaches away from a combination
17 with Reber. The Appellant argues that Fiala relates to pre-paid debit cards
18 to enable metered accounts for the purpose of purchasing goods and services
19 and not to digital works, packages or cards displaying a description of the
20 content of a digital work to be downloaded, sending a request from a
21 merchant node associated with the retail merchant to a remote server to set
22 the status of a desired digital work as available for one-time access (Appeal
23 Br. 11: Fourth ¶ - 13:Third ¶).

24 The Appellant overlooks Freeny as one of the applied references. We find
25 that the combination of Reber and Freeny are combinable to reach the
26 Appellant's claimed invention. The Examiner applied Fiala for its

1 description of debit cards and their authorization transactions, but Fiala's
2 descriptions of these are cumulative and chiefly serve to show that debit
3 cards with their associated authorization are old in the art (FF 53) as context
4 within which one of ordinary skill would understand purchase transactions
5 such as would be implied by Freeny's prepaid card embodiment (FF 21)
6 occur. We find both Reber and Freeny describe downloading digital works
7 (FF 35, 36, 49, and 51), Reber describes packages or cards displaying a
8 description of the content of a digital work to be downloaded (FF 20, 22, 23,
9 and 26-31, and particularly 33 and 35 for uniquely describing), and Freeny
10 describes sending a request from a merchant node associated with the retail
11 merchant to a remote server to set the status of a desired digital work as
12 available for one-time access (FF 49 and 51).

13 The Appellant next contends that it is improper to combine Reber,
14 Fiala, and Freeny. The Appellant contends that Freeny teaches a point of
15 sale location to which a customer goes to purchase material objects which
16 they can later use at home. The Appellant argues that even if Reber, Fiala,
17 and Freeny, were properly combinable, their combination would still not
18 teach or suggest storing a desired digital work on a memory of the customer
19 node such that digital work is available for subsequent use by the customer
20 at the customer node after the customer logs off of the remote server. The
21 Appellant argues that Freeny does not teach storing a digital work on a
22 memory of the customer node such that the digital work is available for
23 subsequent use after the customer logs off the remote server (Appeal Br.
24 13:Third full ¶ - 14).

25 The Appellant does not explain the pertinence of the first argument
26 regarding the point of sale location. We find that whether Freeny teaches a

1 point of sale location to which a customer goes to purchase material objects
2 which they can later use at home does not diminish its teaching value of an
3 authorization implementation for Reber to apply to its downloading with a
4 usage limitation to a node. “When a work is available in one field of
5 endeavor, design incentives and other market forces can prompt variations of
6 it, either in the same field or a different one.” *KSR, id.* at 1740. The
7 Appellant’s second argument is also vague, but we take the Appellant to be
8 taking issue with the location and medium which Freeny uses for download.
9 As to the location, the claim does not specify the location of its customer
10 node. Since Freeny’s manufacturing machines are located at point of sale
11 locations (FF 50), and a customer is similarly located at a point of sale
12 location, by definition of “point of sale,” Freeny’s manufacturing machine is
13 at least a customer node by virtue of being located with Freeny’s customer.
14 As to the medium, Freeny describes that this can be computer disks (FF 48)
15 connected to Freeny’s manufacturing machines. The memory to which the
16 claimed subject matter is downloaded in the claim is described in the
17 Specification as being, by way of example, a computer disk (FF 03). Thus,
18 Freeny’s medium is within the scope of that disclosed by the Appellant.

19 None of the Appellant’s arguments in the Appeal Brief convince us of
20 reversible error on the part of the Examiner.

21 *Reply Brief Arguments*

22 The Appellant initially contends that the Examiner has misconstrued
23 the teachings of Reber and independent claims 1 and 9. The Appellant
24 contends that Reber relates to a network navigation device having human-
25 viewable images associated with a resource (e.g., a web-page) and machine-
26 readable data for automatically navigating to that electronic address (e.g., of

the web-page) when it is read by a data device such that a user does not have to type in an electronic address or other information (Reply Br. 2 - 4: Second ¶).

The Appellant further argues that the teachings of Reber, related to a network navigation device having a code that can be automatically read by specialized equipment, do not teach or suggest the Appellant's limitations related to a card associated with a digital work in which the card includes a card identifier displayed on the outer surface of the card ... the card identifier being a code that includes the desired digital works identification data to uniquely identify the digital work and the package and the card being purchased and in which the outer surface of the card or the package further displays a description of the content of the digital work to be downloaded (Reply Br. 4: Third ¶).

The Appellant is overlooking the more pertinent portions of Reber. It is Reber's machine readable code displayed on Reber's card that includes the desired digital work's identification data to uniquely identify the digital work. The other images with Reber's card provide additional identification, but Reber's machine readable code provides the contended limitation. We find that Reber describes a card associated with a digital work, in which the card includes several card identifiers displayed on the outer surface of the card (FF 20, 22, 23, 26-31, and 33). One of the card identifiers is a code that includes the desired digital work's identification data to uniquely identify the digital work (FF 23, 33, and 35). Reber teaches that the package and the card had been purchased prior to the card being used, as Reber teaches that the card is prepaid (i.e. paid for before being used) (FF 21). Further, the

outer surface of the card or the package displays a description of the content of the digital work to be downloaded (FF 20, 23, 33, and 35).

The Appellant next contends that although Reber does disclose transmitting content over the Internet, that this takes place in the context of downloading content associated with a resource (e.g., a web page) that has been automatically navigated to by an electronic address (e.g., of the web-page) that has been automatically read by a data reading device such that a user has been automatically directed to a web-page of a sponsor associated with the network navigation device. The Appellant argues that there is no teaching or suggestion in Reber of digital works and packages or cards displaying a description of the specific type of content of a digital work that is to be downloaded. The Appellant points to examples of digital works in the Specification, such as page 4, which states: "The digital work may be a book, a periodical subscription (such as a newspaper or magazine), a song, or a collection of songs, a movie, a software program, or the like." The Appellant contrasts these examples with the content of Reber, which the Appellant characterizes as related to unspecified content not known to the user beforehand related to whatever the sponsor of the web-page wants to direct to the user's attention to. The Appellant concludes that Reber is related to a totally different invention for enabling access to a resource web page by utilizing a data reader to automatically link a user to a sponsor's web-site (Reply Br. 4:Bottom ¶ - 5:Third full ¶).

Again, the Appellant overlooks Reber's other descriptions. We find that Reber describes examples of digital works (FF 36) that include movies and software programs which are the types of digital works discussed in Appellant's Specification. Reber describes packages or cards displaying a

1 description, both in visually displayed bar code and with metaphoric images
2 (FF 20, 22, 23, 26-31, and 33), of the specific type of content of a digital
3 work that is to be downloaded, such as a book (FF 23, 33, and 35). Of these
4 findings, FF 33 describing an image of a book with the printed download
5 code in its caption to describe the content that is to be downloaded is
6 particularly specific.

7 The Appellant further argues that Reber does not teach or suggest
8 purchasing from a retail merchant a package including a card associated with
9 the desired digital work, sending a request from a merchant node associated
10 with the retail merchant to a remote server to set a status of a desired digital
11 work as available for one-time access and wherein a desired digital work is
12 received at the customer node and stored on a memory of a customer node
13 such that the digital work is available for subsequent use by the customer at
14 the customer node after the customer logs off of the remote server. The
15 Appellant argues that the claimed invention in which a user may send a
16 request to access a desired digital work from a customer node through a
17 communication network to a remote server, in which the request specifies
18 the desired digital works identification data included in the card identifier
19 displayed on the outer surface of the purchase package, is very different
20 from Reber. The Appellant argues that the claimed invention typically
21 requires that the user type the identification data after previously manually
22 logging on to a web site. The Appellant further argues that nowhere does
23 Reber teach or suggest an outer surface of the card or package displaying a
24 description of content of a digital work to be downloaded. The Appellant
25 contends that this is because Reber does not relate to the purchase,
26 authorization for purchase, and transmission of specific digital works to

1 customers at the customer node. The Appellant further contends that Reber
2 is related to a totally different invention related to a network navigation
3 device having a code that can be automatically read by specialized
4 equipment to enable access to a resource web page wherein the sponsor of
5 the resource is identified by a logo or other graphical representation on the
6 network navigation device (Reply Br. 5: Bottom ¶ - 6: Last full ¶).

7 The Appellant is arguing that Reber is not directed to the claimed
8 invention. “In determining whether the subject matter of a patent claim is
9 obvious, neither the particular motivation nor the avowed purpose of the
10 patentee controls. What matters is the objective reach of the claim. If the
11 claim extends to what is obvious, it is invalid under § 103.” *KSR, id.* at
12 1741-42. We find that Reber implies having paid for and therefore
13 purchased a prepaid card associated with the desired digital work prior to
14 use of the card (FF 21), setting a status in the form of a usage limit of a
15 desired digital work as available for one-time access (FF 41), and wherein a
16 desired digital work is received at the download node and stored on a
17 memory of a download node such that the digital work is available for
18 subsequent use by the user at the download node after the user logs off of the
19 remote server (FF 34, 35, and 57). In Reber’s prepaid card embodiment, the
20 user would have purchased the card prior to use, and would therefore be a
21 customer, and the download node would be a customer node (FF 21). We
22 find that Freeny describes purchasing a download from a retail merchant (FF
23 46) and sending a request from a merchant node associated with the retail
24 merchant to a remote server to set a status of a desired digital work as
25 available for one-time access (FF 49 and 51).

1 We further find that the Appellant's argument that the invention
2 typically requires that the user type the identification data is not
3 commensurate with the scope of the claim, as the claims do not recite typing
4 or any other specific manner of data entry. We further find that the
5 Specification provides examples of a bar code scanner and magnetic reader
6 as alternative input mechanisms for the merchant and, by implication,
7 customer computers (FF 06, 09, and 10). We also find that the Specification
8 and claims as originally filed do not disclose manually logging off a web
9 site, and therefore do not support the claim limitation of logging off. On the
10 other hand, Reber's ftp process (FF 35 and 36) requires logging on and off,
11 between which, an ftp command downloads digital content (FF 57).

12 We further find that Reber describes an outer surface of the card or
13 package displaying a description of content of a digital work to be
14 downloaded (FF 20, 22, 23, 26-31, and 33).

15 The Appellant next *acknowledges the portions cited by the Examiner*
16 *in which Reber describes metering the use of its prepaid card embodiment.*
17 The Appellant contends that all the Reber references to this refer to
18 monitoring a usage parameter associated with the network navigation
19 device. Particularly, the Appellant argues that all of the Reber descriptions
20 of usage limiting relate to monitoring the usage of a user that has been
21 automatically directed to the web-page of a sponsor by the network device
22 of Reber. The Appellant argues that there is no teaching or suggestion in
23 Reber of purchasing from a retail merchant a package including a card
24 associated with a desired digital work, sending a request from a merchant
25 node associated with the retail merchant to a remote server to set a status of
26 a desired digital work available for one-time access such that the desired

1 digital work may be received at a customer node and stored on a memory of
2 a customer node such that the digital work is available for subsequent use by
3 the customer. Appellant argues that Reber's network navigation device that
4 automatically enables access to a web page by utilizing a data reader to
5 automatically link a user to a sponsor's web-site in no way teaches or
6 suggests Appellant's claims related to obtaining a one-time download of a
7 digital work that was purchased from a retail merchant wherein the card
8 and/or package describes the digital work that was purchased by the
9 consumer (Reply Br. 6:Bottom ¶ - 7:Last full ¶).

10 The Appellant is arguing the lack of an explicit teaching or
11 suggestion. *See KSR, id.* at 1741. While all the Reber descriptions of its
12 usage parameter refer to monitoring a usage parameter associated with the
13 network navigation device (FF 21 and 37-43), we find these descriptions
14 describe the claim limitation of “a status of the desired digital work as
15 available for one-time access based on the card identifier of the card
16 associated with the digital work.” See FF 41 in particular. We find that the
17 argument that all of the Reber descriptions relate to monitoring the usage of
18 a user that has been automatically directed to the web-page of a sponsor by
19 the network device of Reber is not commensurate with the scope of the
20 claim. The claim limitation of “searching for the desired digital work” does
21 not preclude assistance in such a search by directing the search to a
22 particular web-page. Further, such direction to a page is merely a file
23 selection from a directory search (FF 59) that Reber's resource computer
24 uses to find the resource. For example, Reber also describes an embodiment
25 that only provides the resource name instead of a complete link. A reference

1 to a name alone is insufficient to directly access a file; it must be searched
2 first (FF 40).

3 We further find that Freeny describes purchasing from a retail
4 merchant a download package (FF 46), Reber describes a card associated
5 with a desired digital work (FF 22, 23, and 26-31), and Freeny describes
6 sending a request from a merchant node associated with the retail merchant
7 to a remote server to set a status of a desired digital work available for one-
8 time access such that the desired digital work may be received at a node
9 used to supply a customer and stored on a memory of that node such that the
10 digital work is available for subsequent use by the customer (FF 49 and 51).
11 Reber describes such a download node as being that of the card owner (FF
12 35 and 36). Both download nodes in Reber and Freeny collect the digital
13 work on media in which the work remains available after the download
14 process terminates. The only distinction between Reber and Freeny is the
15 owner of the node, in both Reber and Freeny the download at the node is for
16 the benefit of the person obtaining the digital work, who is a customer in
17 Freeny, and a user in Reber, but who would be a customer if using a card for
18 which the user had prepaid in Reber. Reber's card provides a mechanism
19 for easily entering the identifying data and controlling data access with its
20 card, and for obtaining payment in advance of a download with prepaid
21 embodiments. As a result, one of ordinary skill, seeking to reduce the
22 investment required in Freeny, would have recognized this could be done by
23 shifting the download target from a merchant owned node to a user owned
24 node, because these features eliminate the need for a separate manufacturing
25 machine in Freeny.

1 The Appellant next contends that Reber teaches away from the
2 Appellant's claimed invention, and further, Fiala does not teach or suggest
3 the limitations for which it is set forth by the Examiner. The Appellant
4 further contends that the Examiner is engaging in the act of impermissible
5 hindsight reconstruction. The Appellant contends that the Examiner found
6 that Reber does not disclose details about marketing Reber's network
7 navigation device in retail stores but that Fiala allegedly teaches users using
8 pre-paid cards that meter access to services, various ways to manufacture
9 pre-paid cards, and displaying and selling packaged pre-paid cards at a retail
10 store. The Appellant disagrees with the Examiner regarding motivation to
11 alter Reber with Fiala to in hindsight approximate Appellant's independent
12 claim (Reply Br. 7: Bottom ¶ - 9:Top ¶).

13 Again, it is not necessary that the art recite an explicit teaching and
14 suggestion. *See KSR, id.* at 1741. We find that although Reber is silent as to
15 marketing details, both Freney and Fiala describe selling. Freney describes
16 selling digital downloads (FF 46). Fiala describes selling prepaid debit cards
17 (FF 53) and waiting until the time of payment to authorize them for use (FF
18 56). While Fiala does not describe using such prepaid cards for digital
19 downloads, Fiala does not discourage one of ordinary skill from such a use,
20 and so cannot be said to teach away from such use. "The prior art's mere
21 disclosure of more than one alternative does not constitute a teaching away
22 from any of these alternatives because such disclosure does not criticize,
23 discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391
24 F.3d 1195, 1201 (Fed. Cir. 2004). We further find that there is no need to
25 alter Reber with Fiala because Fiala is merely cumulative with Reber's

1 description of a prepaid card with limited usage (FF 20 and 21). We find
2 that Freeny describes purchasing a download from a retail merchant (FF 46).

3 The Appellant next contends that Reber directly teaches away from
4 purchasing a card at a retailer and authorizing access to a specific digital
5 work for the purchaser of the card, because Reber is directed to providing
6 easy access to a web-site resource. In support of this argument, Appellant
7 points to several portions of Reber describing free distribution of cards. The
8 Appellant concludes that as set forth in Reber itself, the navigation devices
9 of Reber are meant to be distributed freely to potential customers through
10 inserts in magazines, books, newspapers, through the mail, and distributed
11 freely as business cards, etc. The Appellant contends that Reber's cards are
12 not amenable to modification for purchase in a retail store and to implement
13 retailer activation. The Appellant describes Reber's cards' very advantage
14 as that they are inexpensive and can be distributed freely to direct people to
15 a web-site of a sponsor for future commercial activity. The Appellant
16 concludes that Reber directly teaches away from using the navigation
17 devices in a retail or purchasing manner in order to approximate Appellant's
18 independent claims, such as: purchasing from a retail merchant a package
19 including a card associated with a desired digital work sending a request
20 from a merchant node associated with the retail merchant to a remote server
21 to set a status of a desired digital work as available for one-time access, etc.
22 The Appellant argues that because Reber directly teaches away from the
23 Examiner's proposed combination with Fiala to teach Appellant's claims
24 limitations, that there is no motivation for such a combination, and that
25 therefore, Reber and Fiala are not properly combinable to approximate
26 Appellant's independent claims 1 and 9. The Appellant further argues that

1 Fiala likewise teaches away from a combination with Reber to approximate
2 Appellant's claim limitations because Fiala relates, in general, to packaging
3 for well-known pre-paid debit cards, in particular, a package for holding a
4 data-encoded card associated with a metered account and a method of using
5 the package and card combination to activate the metered account with a
6 certain pre-determined value at the time of purchase of the card and package
7 combination." The Appellant contends that Fiala relates to pre-paid debit
8 cards to enable metered accounts for the purpose of purchasing goods and
9 services, and that there is no teaching or suggestion of Fiala of digital works,
10 packages, or cards displaying a description of the content of a digital work to
11 be downloaded, and sending a request from a merchant node associated with
12 the retail merchant to a remote server to set the status of a desired digital
13 work as available for one-time access (Reply Br. 9:Second ¶ - 11:Second
14 full ¶).

15 This is another argument that selling for payment that which was free
16 is a patentable distinction. It is difficult to see how pricing alone can create
17 a patentable distinction. "When a work is available in one field of endeavor,
18 design incentives and other market forces can prompt variations of it, either
19 in the same field or a different one." *KSR, id.* at 1740. Pricing is certainly a
20 variation subject to market forces.

21 We find that Reber's description of cards distributed freely to
22 potential customers through inserts in magazines, books, newspapers,
23 through the mail, and as business cards does not discourage one of ordinary
24 skill from practicing the prepaid embodiment of Reber's cards (FF 21). *See*
25 *Fulton, id.* We find that prepaid cards are, as described by Fiala, typically
26 purchased in a retail store and thus require retailer activation (FF 56).

1 Adding the activation feature taught by Fiala works to further prevent theft
2 and fraud (FF 55).

3 While among Reber's cards' advantages may be that they are
4 inexpensive, such economy is equally useful in creating prepaid cards,
5 which are for prepaid purchase. Thus, we find that Reber does not teach
6 away from using the navigation devices in a retail environment or from
7 purchasing the cards. Thus, Reber does not negate its own suggestion of the
8 use of a prepaid card, and Fiala merely provides evidence of the notoriety of
9 prepaid cards.

10 Similarly, we find that Fiala does not teach away from the claimed
11 invention because whether Fiala fails to describe digital works, packages, or
12 cards displaying a description of the content of a digital work to be
13 downloaded, and sending a request from a merchant node associated with
14 the retail merchant to a remote server to set the status of a desired digital
15 work as available for one-time access is not probative of whether Fiala
16 discourages such subject matter. *See Fulton, id.*

17 The Appellant next contends that Fiala is not related at all to digital
18 works, but only pre-paid debit cards for pre-paid meter accounts with a
19 certain pre-determined amount of value. The Appellant argues that Fiala is
20 only related to card activation in terms of these types of pre-paid debit cards
21 and in no way teaches or suggests Appellant's claim limitations related to
22 sending a request from a merchant node associated with the retail merchant
23 to a remote server to set a status of a desired digital work as available for
24 one-time access based on the card identifier of the card associated with the
25 digital work, receiving at the remote server the request to access the desired
26 digital work, searching the desired digital work stored on the remote server

1 for the desired digital work specified by the identification data associated
2 with the card identifier displayed on the outer surface of the purchase card
3 and the received request. Instead, the Appellant argues that Fiala teaches the
4 activation of services, such as telephone service, and other types of goods
5 and services that can be purchased in a store. The Appellant argues that
6 Fiala's intended function of providing a metered account with a pre-
7 determined balance for multiple transactions would be destroyed by trying to
8 modify it to teach sending a request from a merchant node associated with a
9 retail merchant to a remote server to set a status of a desired digital work as
10 available for one-time access. The Appellant also argues that the intended
11 function of Fiala would be destroyed if it were attempted to be modified
12 away from a pre-paid debit card with a metered account for multiple
13 transactions for goods and services to a one-time access based on a card
14 identifier of a card for a digital work. The Appellant further argues that
15 nowhere does Fiala teach or suggest digital works, sending requests to
16 merchant nodes for digital works, or searching digital works stored on a
17 remote server for desired digital works specified by a card (Reply Br.
18 11:Third full ¶ - 13:Second full ¶).

19 We find that Fiala describes the known generic features of prepaid
20 cards, which provide further evidence, but are otherwise cumulative with the
21 teachings in Reber and Freeny. Thus, Fiala describes prepaid cards, such as
22 used by Reber, that are put to a use that Fiala does not describe. "Common
23 sense teaches ... that familiar items may have obvious uses beyond their
24 primary purposes, and in many cases a person of ordinary skill will be able
25 to fit the teachings of multiple patents together like pieces of a puzzle."

1 *KSR, id.* at 1742. Thus, Reber describes a use for the ordinary prepaid card
2 of Fiala.

3 We find that sending a request from a merchant node associated with
4 the retail merchant to a remote server to set a status in the form of a metered
5 account of a card based on the card identifier of the card is described by
6 Fiala (FF 56). As to the remaining claim elements cited by the Appellant,
7 Reber describes setting a status in the form of a usage limit of a desired
8 digital work as available for one-time access based on the card identifier of
9 the card associated with the digital work (FF 41), receiving at the remote
10 server the request to access the desired digital work and searching the
11 desired digital work stored on the remote ftp server for the desired digital
12 work specified by the identification data associated with the card identifier
13 displayed on the outer surface of the purchase card and the received request
14 (FF 35 and 36). Nothing in Fiala discourages one of ordinary skill from
15 practicing these steps of Reber, and thus Fiala cannot be said to teach away
16 from the claimed invention. *See Fulton, id.* The Appellant's arguments that
17 Fiala's functions are exclusively that of providing multiple items or services
18 is simply not borne out by Fiala. Fiala describes exemplary embodiments,
19 but in no way excludes the use of its cards to only those embodiments.
20 Rather, as described by Reber, such cards may be for one time or multiple
21 uses (FF 40-42). Neither, use would be discouraged by Fiala. Finally, we
22 find that Freeny describes digital works, sending requests to merchant nodes
23 for digital works, and searching digital works stored on a remote server for
24 desired digital works specified by a card (FF 46-51).

25 The Appellant next argues that Freeny teaches a point of sale location
26 to which a customer goes to purchase material objects which they can later

1 use at home. The Appellant also argues that there is no motivation to
2 combine Reber, with Fiala, and then with Freeny, except impermissible
3 hindsight reconstruction, and that even if Reber, Fiala, and now Freeny,
4 were properly combinable, Freeny does not teach or suggest Appellant's
5 claim limitations related to: transmitting the desired digital work from the
6 remote server through the communications network to the customer node,
7 receiving at the customer node the desired digital work, and storing a desired
8 digital work on a memory of the customer node such that digital work is
9 available for subsequent use by the customer at the customer node after the
10 customer logs off of the remote server (Reply Br. 13:Last full ¶ - 15:Third
11 full ¶).

12 The Appellant does not state how Freeny's teaching of a point of sale
13 location to which a customer goes to purchase material objects which they
14 can later use at home presents a patentability issue. To the extent the
15 Appellant is arguing that the point of sale location is not a customer node,
16 the only distinction is the characterization of a node as relating to a
17 customer, since the claim does not specify a location. Since Freeny's
18 manufacturing computer is used to create a digital work for a customer, it
19 can fairly be characterized as a customer node, as discussed, *supra*. Also,
20 Reber implies that with its prepaid card embodiment, the card, which is
21 prepaid prior to use, would have been purchased by virtue of having been
22 prepaid for by the time of use and therefore the user would be a customer,
23 and the user's node would be a customer node (FF 21).

24 As we found *supra*, Freeny provides an implementation for the
25 authorization mechanism required by Reber, and Reber provides an
26 implementation for the data entry mechanism required by Freeny. Thus,

each of Reber and Freeny suggests the describe the implementation techniques missing from the other reference. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR, id.* at 1742.

We find that Freeny describes transmitting the desired digital work from the remote server through the communications network to the manufacturing machine, receiving at the manufacturing machine the desired digital work, and storing a desired digital work on a memory of the manufacturing machine such that digital work is available for subsequent use by the customer at the customer node after the customer logs off of the remote server (FF 49 and 51). The manufacturing machine can be fairly characterized as a customer node, as we construed, *supra*, since it is a node for the benefit of a customer, and the claim does not require actual ownership by a customer. Reber explicitly describes downloading, receiving and storing via ftp to a customer node on a memory of the customer node such that digital work is available for subsequent use by the customer at the customer node after the customer logs off of the remote server (FF 35 and 36).

Request for Rehearing Arguments

The Appellant argues that even if the references are combinable, the asserted combination does not disclose all of the required claim elements. Specifically, the Appellant argues that none of Reber, Fiala, or Freeny disclose, teach, or suggest the claim recitation of "storing the desired digital work on a memory of the customer node such that the digital work is

1 available for subsequent use by the customer at the customer node after the
2 customer logs off of the remote server."

3 The Appellant is calling for evidence that the art describes a claim
4 limitation. We find that Freeny's manufacturing computer is used to create a
5 digital work for a customer (FF 46, 49, and 51), and so it can fairly be
6 characterized as a customer node, as we discussed, *supra*. We find that
7 Reber describes storing a desired digital work on a memory of the node such
8 that the digital work is available for subsequent use by the user at the node
9 after the user logs off of the remote server following an ftp transfer (FF 35,
10 36, and 57). Reber implies that in the prepaid card embodiment, the card,
11 which is prepaid for prior to use, would have been purchased by virtue of
12 having been prepaid for by the time of use. Therefore the user of the card
13 would be a customer, and the user's node would be a customer node (FF 21).

14 The Appellant argues that Freeny does not cure the deficiencies of
15 Reber in view of Fiala. The Appellant contends that Freeny uses the term
16 "point of sale location" to mean "retailer" and "retail outlet," and explicitly
17 states that "[t]he point of sale location is a location where a customer goes to
18 purchase material objects embodying predetermined or preselected
19 information." At the point of sale location, information is transferred to a
20 "material object," such as a cassette tape or eight-track. The Appellant
21 argues that the stated purpose of Freeny is to reduce the amount of inventory
22 and associated space a retailer must possess, and that at no point does Freeny
23 discuss a "customer node" which stores the digital work for subsequent use
24 by the customer at the customer node after the customer logs off of the
25 remote server. The Appellant contends that it is the customer node that is
26 connected to the remote server -- not a point of sale location. The Appellant

1 argues that claim 1 recites that a digital file is "stor[ed] on a memory of the
2 customer node" and "the digital file is available ... at the customer node after
3 the customer logs off from the remote server." The Appellant contends that
4 this is the same "customer node" that claim 1 earlier recites is "intermittently
5 coupled through a communications link" to the "remote server"; and the
6 same "customer node" that "send[s] a request to access the desired digital
7 work ... through the communications network to the remote server." The
8 Appellant argues that in Freeny, a cassette tape or eight-track is not
9 intermittently coupled to the remote server, and a cassette tape or eight-track
10 does not send a request to the remote server. The Appellant concludes that
11 Freeny does not disclose this element; and that the material objects recited
12 by Freeny are incapable of sending such a request to a remote server
13 (Request 5–8: Top ¶)).

14 This argument is an attempt to attack the rejection by attacking
15 references individually. One cannot show nonobviousness by attacking
16 references individually where the rejections are based on combinations of
17 references. *See Keller, id.* We find that Reber describes storing a desired
18 digital work on a memory of the customer node such that the digital work is
19 available for subsequent use by the customer at the customer node after the
20 customer logs off of the remote server following an ftp transfer (FF 35, 36,
21 and 57).

22 We find that, as to Freeny, this argument is not commensurate with
23 the scope of the claim. Freeny's manufacturing machine is a machine on a
24 network to which a digital work is downloaded for a customer when the
25 manufacturing machine is intermittently coupled to Freeny's information
26 control machine on a remote server (FF 49-51). Thus, Freeny's

1 manufacturing machine is within the scope of a customer node. Nothing in
2 claim 1 limits the phrase "customer node" so that it may not be at a point of
3 sale location. Indeed, the very placement at a point of sale location is
4 indicative of the manufacturing machine's use for a customer. Further, the
5 Specification discloses a kiosk, which is generally a device in a commercial
6 environment and frequently a point of sale device, as an embodiment of a
7 customer node (FF 04). Thus, not only is the claim broader than the
8 Appellant's argument; the Specification suggests an embodiment as in
9 Freeny. Finally, the Appellant's argument that the material objects recited
10 by Freeny are incapable of sending such a request to a remote server appear
11 irrelevant as Freeny is very clear that it is the manufacturing machine, not
12 the media that the manufacturing machine downloads to, that communicates
13 with the remote server's information control machine (FF 49-51).

14 The Appellant next contends that the combination of Reber, Fiala, and
15 Freeny, does not disclose the element of "searching the digital works stored
16 on the remote server for the desired digital work specified by the card
17 identifier." The Appellant contends that Reber discloses a network
18 navigation device that lists a particular network address, and assists the user
19 in arriving at that particular network address, but that Reber fails to disclose
20 the step of "searching the digital works stored on the remote server for the
21 desired digital work specified by the card identifier" for at least two (2)
22 reasons. First, the Appellant contends that the present invention is limited to
23 a search on a particular remote server; Reber discloses a network address
24 that may be located anywhere on a network. Second, the Appellant contends
25 that Reber directs a user to a specific location, it does not "search" a library

of digital works to find a specific one. The Appellant argues that neither Fiala or Freeny cure this deficiency (Request 8: Second and third ¶'s).

We find that the Appellant's first argument that the claim limits the search to a particular server, is not commensurate with the scope of claim 1. We find that the preamble of claim 1 recites "a remote server," which is unconstrained other than in being remote. The subsequent recitation of searches being performed on that server does not restrict where that server can be located. Any server on the Internet, appropriately programmed, would fall within the scope of claim 1's remote server.

We find that the Appellant's second argument fails in the light of Reber's teachings. Reber describes how it catalogs the works that may be downloaded in a database that is indexed by the card identifiers and whose records identify the resource to be provided (FF 40 and 41). Looking up the card identifier in Reber's database is a search of the database (FF 58), which, since the database contains descriptions of the works, is a searching of the digital works. Even were Reber to rely on a file system instead of a database of identifiers, the file system itself is a database which is searched (FF 59). Finally, Reber's database identification of the work may be a resource name (FF 40), which would then have to be searched to find its location.

The Appellant next argues that the cited references teach away from the stated combination. The Appellant contends that Reber teaches away from the combination with Fiala and Freeny because in Reber, a user accesses the resource by reading the machine-readable data using a data reader rather than by typing an electronic address. The Appellant argues that in contrast, the present invention requires a direct user input of a desired

1 digital work's non-machine readable identification data (Request 9 - 11:First
2 full ¶).

3 We find the Appellant's argument is not commensurate with the scope
4 of claim 1. There is no recitation of typing data as a vehicle for direct data
5 input, or of the displayed data not being machine readable, in claim 1. In
6 contrast, the Specification recites that the customer node can use a magnetic
7 card reader (FF 10) and suggests the use of a bar code scanner, since the
8 customer node may be configured the same as the disclosed merchant node
9 (FF 06), which may have a bar code scanner (FF 09). The Appellant has
10 made no contention that the cited references would discourage one of
11 ordinary skill from the actual claim limitations surrounding data entry of
12 "sending a request." *See Fulton, id.*

13 The Appellant next argues that Freeny teaches away from the
14 combination asserted by the Office. The Appellant contends that Freeny
15 discloses a system and method for reproducing information in a material
16 object at a point of sale. The Appellant further contends that Freeny
17 discusses -- and dismisses -- delivering such information to the consumer at
18 the consumer's home. The Appellant concludes that requesting a specific
19 digital work from, and delivering the specific digital work to, a customer
20 node is discouraged by Freeny (Request 11:Bottom ¶ - 12:First full ¶).

21 We find the Appellant's argument is not commensurate with the scope
22 of claim 1. There is no recitation of delivering information at the consumer's
23 home in claim 1. As we construed, *supra*, the phrase "customer node" is a
24 node that relates to a customer and Freeny's manufacturing machine which
25 downloads a file for a customer relates to a customer.

1 We further find that Freeny did not reject the idea of delivering data to
2 a home. The Appellant cites Freeny 3:62-4:7 for this argument (Request
3 11:Footnote 33). We find this portion of Freeny only recites the practice of
4 delivering television to a home as background. Freeny at no point
5 discourages the placement of its manufacturing machines in a home. We
6 note that Freeny was filed in 1983, before Internet downloading at home
7 became commonplace, and as such, Freeny relied on the commonly used
8 technology of its day. However, one of ordinary skill in the art would have
9 found it obvious to combine an old electromechanical device such as
10 described by Freeny with electronic circuitry

11 to update it using modern electronic components in order to gain the
12 commonly understood benefits of such adaptation, such as decreased
13 size, increased reliability, simplified operation, and reduced cost. . . .
14 The combination is thus the adaptation of an old idea or invention . . .
15 using newer technology that is commonly available and understood in
16 the art.

17 *Leapfrog, id.* at 1163. Thus, updating Freeny's manufacturing machines by
18 replacing audio tapes and the like with a hard drive in the era of internet
19 downloading as taught by Reber would have been an obvious technological
20 update.

21 The Appellant next argues that no motivation for combining the
22 references has been articulated. The Appellant argues that the Office is
23 asserting that the missing claim elements are obvious in light of the nature of
24 the problem to be solved. However, this "begs the question" of whether "this
25 problem had been previously identified anywhere in the prior art."
26 Appellant contends that nowhere in the prior art is this problem identified.
27 The Appellant admits that under the precedent of *KSR, id.* at 1741, an
28 obviousness analysis need not seek out precise teachings -- but rather may

1 be found in implicit factors. The Appellant argues that the Office has not
2 identified such implicit factors and has not made the relevant obviousness
3 analysis explicit (Request 12:Second full ¶ - 14:First full ¶).

4 We made such findings explicit in the section entitled *Board of Patent*
5 *Appeals and Interferences Findings and Holdings, supra*. There we found
6 that each of Reber and Freeny omit certain implementation details that the
7 other provides. The problem to be solved that the Appellant argues is
8 missing is thus the problem of filling in such implementation details. One of
9 ordinary skill knew that to practice any system, the implementation details
10 of each component of the system had to be ascertained. Thus, the
11 identification of a system to be practiced was in itself an identification of the
12 problems of identifying the implementation details of the system's
13 components. Reber provides the data entry details for Freeny and Freeny
14 provides the authorization details for Reber.

15 The Appellant next contends that combining Reber with Fiala and
16 Freeny changes the principle of operation of Reber. The Appellant argues
17 that Reber must be modified: (1) in order to provide a purchasing
18 mechanism for the prepaid card, and thereby attract customers to the store
19 and service willing to pay for prepaid access to digital content; (2) in order
20 to activate the prepaid card sold by the retailer, and thereby enable
21 customers to access digital content sold through the retail establishment; and
22 (3) in order to provide off-line content usage, and thereby attract customers
23 to the retail store and online content distribution service. With regard to the
24 first modification, the Appellant argues that the principle operation of a
25 network navigation device is incongruous with a purchasing mechanism for
26 a prepaid card. With regard to the second modification, the Appellant

1 argues that limiting customers from accessing digital content until activation
2 of a prepaid card significantly changes the operation of Reber, and that the
3 ability to provide "off-line content usage" is in direct opposition with the
4 teachings of Reber (Request 14: Last full ¶ - 16:First full ¶).

5 As to the Appellant's argument that the combination would change
6 the principle of operation citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)
7 (Request 14:Footnote 43), while *Ratti* held that a combination of references
8 that would require a substantial reconstruction and redesign of the elements
9 shown the prior art as well as a change in the basic principles under which
10 the prior art was designed to operate is not a proper ground for an
11 obviousness rejection, 270 F.2d at 813, what *Ratti* was referring to was
12 reconstruction and redesign of how all the elements interrelate in a manner
13 relying on operational principles unforeseeable to a person of ordinary skill.

14 In *Ratti*, claims were directed to an oil seal comprising a bore
15 engaging portion with outwardly biased resilient spring fingers inserted in a
16 resilient sealing member. The primary reference relied upon in a rejection
17 based on a combination of references disclosed an oil seal wherein the bore
18 engaging portion was reinforced by a cylindrical sheet metal casing. Its seal
19 was incompressible and the device required rigidity for operation, whereas
20 the claimed invention required resiliency.

21 But Reber's user download (FF 22), coupled with Freeny's purchase
22 and authorization of such downloads (FF 49), would not do such violence to
23 the operating principles of Reber. Modifications by substitution, even if
24 they omit the subject matter portion which a prior art patentee apparently
25 regarded as his contribution to the art along with such advantages as it might
26 provide, where the modified apparatus is obvious in view of the prior art and

1 where the retained portion of the subject matter will operate on the same
2 principles as before, “are not authority for holding a rejection improper
3 under such circumstances.” *In re Umbarger*, 407 F.2d 425, 430-31 (CCPA
4 1959), distinguishing *Ratti*. In this case, modifying Reber by applying
5 Freeny’s card payment, download authorization, and retention of the
6 downloaded work, still operates on the principles of both Reber and Freeny.
7 Indeed, as we have held *supra*, Reber describes prepaid cards (FF 21), a
8 database containing authorizations (FF 39) and retention of the work
9 following an ftp download (FF 57).

10 The Appellant next contends that combining Reber with Fiala and
11 Freeny changes the principle operation of Fiala. Appellant asserts that Fiala
12 is directed to packaging for a stored value card with an associated metered
13 account and the activation of the metered account. Appellant states that the
14 metered account activated by Fiala is disclosed to be a telecommunications
15 account, and be used for multiple transactions. Appellant argues that the
16 present invention does not require such an activation, but rather a limited
17 activation, setting “the status of the desired digital work as available for a
18 one-time access based on the card identifier of the card associated with the
19 digital work.” Appellant further argues that the activation of a metered
20 account for unrestricted use (up to the balance of the metered account) does
21 not disclose the limited activation for a one-time access of a particular file.
22 Appellant concludes that in order to combine Fiala with Reber and Freeny to
23 disclose the present invention, Fiala would be modified to provide a one-
24 time access, thereby changing the principle operation of Fiala and its
25 metered account activation (Request 16: Bottom ¶ - 17:Top ¶).

1 We point again to *Umbarger, id.* In this case, modifying Fiala by
2 applying Freeny's and Reber's one time use restriction, still operates on the
3 principles of Fiala, Reber, and Freeny. Certainly, since the limit of use in
4 Fiala is arbitrary, Fiala's card would operate in exactly the same manner if it
5 were restricted to one single use. It would be just that the single use would
6 define the limit of use that Fiala describes its cards as having.

7 The Appellant next contends that combining Reber with Fiala and
8 Freeny changes the principal operation of Freeny. The Appellant argues that
9 Freeny is directed to systems and methods for reducing inventory at a store,
10 by reproducing information in material objections at a point of sale location,
11 and that, in order to effectuate this goal, Freeny discloses a reproduction unit
12 located at the point of sale. The reproduction unit reproduces information in
13 a material object. The Appellant contends that the present invention is
14 distinguishable, in that it requires a "customer node" that: is intermittently
15 coupled to the remote server; that receives a desired digital work; and that
16 "send[s] a request to access the desired digital work...through the
17 communications network to the remote server." The Appellant concludes
18 that in order to disclose the present invention from a combination of Reber,
19 Fiala, and Freeny, the *material object* of Freeny would have to "send[] a
20 request to access the desired digital work...through the communications
21 network to the remote server" (Request 17:First full ¶ - 18: Top ¶).

22 This is apparently a repetition of the Appellant's argument, *supra*, that
23 the material objects recited by Freeny are incapable of sending such a
24 request to a remote server appear. As we found in response to that earlier
25 instance of this argument, Freeny is very clear that it is the manufacturing
26 machine, not the media that the manufacturing machine downloads to, that

1 intermittently contacts and communicates with the remote server's
2 information control machine to access and download a file (FF 49-51). As
3 to the operation of this manufacturing machine, again, pointing to
4 *Umbarger, id.*, modifying Reber by applying Freeny's authorization
5 communication between its manufacturing machine and its information
6 control machine, still operates on the principles of Freeny, since it does not
7 change the operation of Freeny, and neither does it alter the operation of
8 Reber (or the cumulative Fiala reference).

9 The Appellant next contends that combining Reber with Fiala and
10 Freeny would render Reber inoperable or unsatisfactory for its intended
11 purpose. The Appellant argues that the electronic network disclosed by
12 Reber is the Internet and World Wide Webs. The Appellant argues that the
13 present invention requires searching a specific remote server for a specific
14 digital file. The Appellant contends that modifying Reber in view of Fiala
15 and Freeny to disclose the present invention effectively eliminates the
16 network navigation aspect of Reber -- which the Appellant argues is the very
17 point, the intended purpose. The Appellant further argues that, in
18 accordance with Reber, a user inputs a network location into a computer.
19 The network location may be input via manual input, or preferably, via a
20 machine readable indicia. The computer then automatically navigates to the
21 particular network location and automatically displays the content on the
22 particular network location -- content which the user may be unaware of
23 until it is displayed. The Appellant contends this is in contrast with the
24 invention which requires the selection of a specific digital work; the user is
25 not navigated to a network location and displayed whatever content is there;
26 rather, the user determines in advance which specific work to access. The

Appellant argues that Reber does not disclose the location and distribution of a specific digital work, and to modify Reber to do so destroys the navigational capabilities of Reber, and the intent to provide an answer to the "much-hyped but difficult-to-use linking of computers around the world." The Appellant also argues that the network navigation device of Reber is intended to be "produced inexpensively for wide distribution" as "inserts in magazines, newspapers, or other publications," or they can be "distributed by mail," or "distributed as one distributes business cards." The Appellant argues that each of these distribution methods is free to the recipient (Request 18: Second full ¶ - 20: First full ¶).

Although the Appellant has couched this argument as one of inoperability, we find that Reber already describes as an operable embodiment what the Appellant is arguing would be the inoperable result after the argued modifications. We find that the server and file that are searched are pointed to by the description on Reber's card. This describes the operation of the ftp download embodiment of Reber (FF 35 and 36). The Appellant's Specification discloses that the customer node connects to the internet (FF 03) just as Reber's user's node does, so applying Reber's connection to the internet would hardly render Reber inoperable. While claim 1 requires that the digital work be found after a search, so does Reber, as for example when an ftp file target is displayed on Reber's card (FF 35 and 36). Nothing in claim 1 recites that the user determines in advance which work is accessed as the Appellant argues; rather the work is that identified by the card, not the user. Again, this is the same as in Reber in which a card's identifier describes, through a database, a file that either is, or is accessed by, a resource (FF 34-36). As to the argument regarding

1 awareness, the claim recites no limitation regarding the level of a user's
2 awareness of the content that is downloaded, and Reber clearly provides a
3 human viewable image intuitively associated with the resource (FF 20),
4 which is the digital work itself for at least an ftp download (FF 57). As to
5 the argument of free distribution, while it may be that Reber's card is to be
6 produced inexpensively, this does not mandate that they be given away for
7 free, and Reber even describes a prepaid embodiment (FF 21).

8 The Appellant next contends that combining Reber with Fiala and
9 Freeny would render Freeny inoperable or unsatisfactory for its intended
10 purpose. The Appellant argues that Freeny is directed to reproducing
11 information in material objects at a point of sale location, and distinguishes
12 the Appellant's invention as requiring a customer node that is intermittently
13 coupled to the remote server, that receives a desired digital work, and
14 "send[s] a request to access the desired digital work...through the
15 communications network to the remote server." The Appellant contends that
16 in order to disclose the present invention from a combination of Reber,
17 Fiala, and Freeny, the material object of Freeny would have to "send[] a
18 request to access the desired digital work...through the communications
19 network to the remote server." The Appellant argues that the material
20 objects recited by Freeny are not operable to send a request, but are simply
21 recording or memory devices. The Appellant further argues that modifying
22 Freeny to be included in the combination of Reber and Fiala renders Freeny
23 entirely unsatisfactory for its intended purpose because Freeny is intended as
24 a means to reduce the amount of inventory a store must carry. The
25 Appellant argues that modifying Freeny as stated would allow customers to
26 save selected information (or digital files) at the customer node -- not at the

1 point-of-sale and effectively cuts the merchant out of the equation, therefore
2 rendering the combination unsatisfactory for Freeny's intended purpose
3 (Request 20: Second full ¶ - 21: Top ¶).

4 The Appellant argues again that the media attached to Freeny's
5 manufacturing machine, rather than Freeny's manufacturing machine itself,
6 would have to communicate with the remote server. As the Appellant states,
7 it must be a machine that performs such communication. Freeny has that
8 machine in its manufacturing machine. Certainly requiring Freeny's
9 manufacturing machine to operate in exactly the manner it is so described in
10 Freeny could not render Freeny inoperable or unsuitable.

11 The Appellant's final argument that eliminating Freeny's removable
12 media such as tapes would cut out the merchant is of course belied by both
13 Reber's and Fiala's description of prepaid cards. Clearly Reber's
14 embodiment of prepaid cards suggests that Freeny's merchant would sell the
15 card for subsequent download instead of a tape for immediate download.
16 Thus, modifying Freeny to substitute a prepaid card for removable media
17 would not render Freeny inoperable or unsuitable for its intended purpose.

18 The Appellant next argues that the differences between the claimed
19 subject matter and the prior art prevents a finding of obviousness because
20 the prior art of record does not teach all of the elements of the present
21 invention as claimed, and the references have different intended purposes
22 and principle of operations, such that combination is improper. The
23 Appellant argues that Reber discloses a network navigation device; Fiala
24 discloses an unlimited activation of a metered account; and Freeny discloses
25 an inventory control device for recording information at a point of sale. The
26 Appellant argues that that these references would be combined to disclose a

1 method of distributing digital works, where the works are available for a
2 one-time access from a customer node, the customer node sends a request to
3 access the digital work, and the digital work is made available for
4 subsequent use at the customer node after disconnecting from a server is
5 nonsensical. The Appellant refers to these distinctions as glaring differences
6 between the references and the present invention and argues that the only
7 way one of ordinary skill in the art could have combined them is by using
8 impermissible hindsight and the present invention as roadmap (Request 21:
9 Bottom two ¶¶s).

10 The Appellant is arguing that the applied art are disparate.

11 When a work is available in one field of endeavor, design incentives
12 and other market forces can prompt variations of it, either in the same
13 field or a different one. If a person of ordinary skill can implement a
14 predictable variation, § 103 likely bars its patentability. For the same
15 reason, if a technique has been used to improve one device, and a
16 person of ordinary skill in the art would recognize that it would
17 improve similar devices in the same way, using the technique is
18 obvious unless its actual application is beyond his or her skill.

19 *KSR, id.* at 1740.

20 More to the point, the Appellant is very selective in summarizing each
21 of the references. A more pertinent characterization of the references is that
22 Reber discloses a download service that relies upon a card with an identifier
23 of the download and protects against unauthorized downloads with a usage
24 parameter; Freeny discloses a download service in which the authorization
25 transactions are explained more explicitly than in Reber, although its data
26 entry mechanisms need the implementation details of a reference such as
27 Reber; and Fiala is a cumulative reference that discloses the notoriety of
28 prepaid cards such as disclosed in Reber. From such a perspective, not only

1 is the combination not resultant from hindsight, the Reber and Freeny
2 references each suggest the need of the other.

3 Thus none of the Appellant's arguments are persuasive and we find
4 that the Appellant has failed to meet its burden of showing that the Examiner
5 erred in rejecting claim 1. Since the Appellant only argued for the
6 patentability of claim 1, the remaining claims in the rejection, viz. claims 6
7 through 9, and 13 through 15, stand or fall with claim 1. 37 C.F.R.
8 § 41.37(c)(1)(vii) (2007).

9 *Claims 4 and 12 rejected under 35 U.S.C. § 103(a) as obvious over Reber,*
10 *Fiala, Freeny, and Official Notice.*

11 There are no issues under contention as to these claims and they
12 depend from independent claims 1 and 9 whose rejection we sustained
13 above. The Appellant is relying on the arguments in support of patentability
14 of claim 1 to show patentability of these claims. Thus, our analysis negating
15 the patentability of claim 1 over the art which is also applied in this rejection
16 is equally applicable to these claims. There are no contentions regarding
17 claim limitations for which the Official Notice was applied. Accordingly we
18 sustain the Examiner's rejection of claims 4 and 12 under 35 U.S.C. § 103(a)
19 as obvious over Reber, Fiala, Freeny, and Official Notice.

20 *Claim 5 rejected under 35 U.S.C. § 103(a) as obvious over Reber, Fiala,*
21 *Freeny, and White.*

22 There are no issues under contention as to this claim and it depends
23 from independent claim 1 whose rejection we sustained above. The
24 Appellant is relying on the arguments in support of patentability of claim 1
25 to show patentability of this claim. Thus, our analysis negating the

1 patentability of claim 1 over the art which is also applied in this rejection is
2 equally applicable to this claim. There are no contentions regarding claim
3 limitations for which White was applied. Accordingly we sustain the
4 Examiner's rejection of claim 5 under 35 U.S.C. § 103(a) as obvious over
5 Reber, Fiala, Freeny, and White.

6 NEW GROUND OF REJECTION

7 The following new ground of rejection is entered pursuant to
8 37 C.F.R. § 41.50(b) (2007).

9 Claims 1, 4 through 9, and 12 through 15, are rejected under 35
10 U.S.C. § 112, first paragraph as not being supported by the written
11 description as originally filed.

12 The two independent claims 1 and 9 recite storing a work “such that
13 the digital work is available for subsequent use by the customer at the
14 customer node after the customer logs off of the remote server.”

15 The disclosure as filed contained no written description of logging off or
16 otherwise exiting the remote server as currently recited in the limitation
17 “such that the digital work is available for subsequent use by the customer at
18 the customer node after the customer logs off of the remote server” of claims
19 1 and 9. This limitation was added to claims 1 and 9 by amendment dated
20 February 24, 2005. The Appellant did not present any indication as to where
21 support for this amendment might be found in the original disclosure (FF
22 13). We have examined the Specification and found no support.

23 The closest the originally filed disclosure comes to this is describing
24 that when the desired digital work is received at the customer node, it is
25 stored on the memory of the customer node “for subsequent access and use

by the customer” (Specification 12:17-19) (FF 11). However this portion of the written description only describes the work as being available after reception, not after logging off or exiting the remote server (FF 12).

Thus, claims 1 and 9 are not fully supported by the written description as originally filed. *See In re Rasmussen*, 650 F.2d 1212, 1214-15 (CCPA 1981). Dependent claims 4 through 8 and 12 through 15 are similarly unsupported by the originally filed disclosure because they fully incorporate the claimed subject matter, and thus this limitation, of independent claims 1 and 9.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1, 4 through 9, and 12 through 15 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

We enter a new ground of rejection of claims 1, 4 through 9, and 12 through 15 under 35 U.S.C. § 112, first paragraph, as not being supported by the written description as originally filed.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1, 6 through 9, and 13 through 15 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, and Freeny is sustained.
- The rejection of claims 4 and 12 under 35 U.S.C. § 103(a) as obvious over Reber, Fiala, Freeny, and Official Notice is sustained.

1 • The rejection of claim 5 under 35 U.S.C. § 103(a) as obvious over
2 Reber, Fiala, Freeny, and White is sustained.

3 • We enter a new ground of rejection of claims 1, 4 through 9, and
4 12 through 15 under 35 U.S.C. § 112, first paragraph, as not being
5 supported by the written description as originally filed.

6 This decision contains a new ground of rejection pursuant to
7 37 C.F.R. § 41.50(b) (2007).

8 Our decision is not a final agency action.

9 37 C.F.R. § 41.50(b) provides that Appellant, *WITHIN TWO*
10 *MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the
11 following two options with respect to the new rejection:

12 (1) *Reopen prosecution*. Submit an appropriate
13 amendment of the claims so rejected or new evidence relating
14 to the claims so rejected, or both, and have the matter
15 reconsidered by the Examiner, in which event the proceeding
16 will be remanded to the Examiner. . . .

17
18 (2) *Request rehearing*. Request that the proceeding be
19 reheard under § 41.52 by the Board upon the same record. . . .
20

21 No time period for taking any subsequent action in connection with
22 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
23 § 1.136(a)(1)(iv) (2007).

24 AFFIRMED; 37 C.F.R. § 41.50(b)
25
26
27
28
29

1 hh

2

3

4 HUNTON & WILLIAMS, LLP
5 INTELLECTUAL PROPERTY DEPARTMENT
6 RIVERFRONT PLAZA, EAST TOWER
7 951 EAST BYRD ST.
8 RICHMOND, VA 23219-4074